

### **REMARKS**

Applicants respectfully request reconsideration. Claims 1-30 and 34-36 were previously pending in this application. By this amendment, Applicants are not canceling or adding any claims. As discussed below, Applicants have amended claims 1, 13, 34, and 35. As a result, claims 1-30, and 34-36 are still pending for examination with claims 1, 8, 13, 23, 26, 34, and 35 being independent claims. No new matter has been added.

Applicants would like to thank Examiner Patterson for her courtesies during a telephone interview with Shannon Pratt on January 24, 2006. The rejections in view of Kendall (U.S. Patent No. 6,601,321) were discussed. The substance of the discussion is incorporated into the following remarks.

#### ***Allowable Subject Matter***

Applicants gratefully acknowledge the Examiner's finding that claims 8-12, and 23-26 are allowed and that claims 15-19, 22, and 27 would be allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims. Claims 15-19, 22, and 27 have not been rewritten into independent form, but each depends on independent claim 13, which is believed to be allowable for the reasons discussed below.

#### ***Rejections Under 35 U.S.C. §102***

In the Office Action, claims 1, 2, 6, 7, 13, 14, 20, 21, 28, 29, 30, and 34-36 were rejected under 35 U.S.C. §102(b) as being anticipated by Kendall (U.S. Patent No. 6,601,1321). Applicants have amended independent claims 1, 13, 34 and 35 to more clearly distinguish over Kendall.

Independent claims 1, 13, 34, and 35 have all been amended to clarify that the claimed midsole insert includes an energy return grid system forming a *taut* lattice pattern, *which forms a spring-like member capable of deflection and return*. Support for these amendments may be found at least one page 9, approximately on lines 21-27, and on page 12, approximately on lines 10-13.

As discussed in the prior Amendment submitted on September 19, 2005, Kendall describes a shoe sole construction which includes a hammock-like lattice for supporting and controlling a foot. The hammock-like structure substantially conforms to the foot such that the foot is suspended above

the base of the shoe. Kendall states that by suspending the foot, portions of the foot are largely protected from the shock which is transmitted upwardly from the ground during gait. (Kendall, Col. 2, lines 27-29).

Furthermore, Kendall specifically teaches away from the use of an energy return grid system in the “Related Art” section. In this section, Kendall describes energy return systems, but states that such designs may cause the foot to become unstable, and may also lead to foot fatigue because the foot would absorb and deflect a significant amount of force generated during gait.

As discussed during the recent telephone interview, the Examiner explained that although the primary purpose of the lattice in Kendall is not to serve as an energy return system, her position was that the lattice in Kendall may inherently return some energy. During the telephone interview, possible claim amendments were discussed to clarify that the present claims were not directed towards a midsole insert having a grid system structured akin the hammock-like lattice of Kendall, that merely may inherently return some energy. The Examiner suggested amending the claims with language which further described the lattice (i.e. a property, material, etc.) that Kendall specifically described as not being, or that Kendall would teach away from incorporating into their hammock-like structure.

In view of the telephone discussion, it is important to note that Kendall specifically teaches that the hammock-like “lattice is not tautly strung within its scaffolding, and does not primarily serve as an energy return system (e.g. a trampoline-like structure). Rather, the invention provides gentle, stable, controlled support by pulling and holding the foot, rather than pushing it into position within a shoe.” (Kendall, Col. 5, lines 9-15). Definitions in common dictionaries, such as Merriam-Webster’s Online dictionary, [www.m-w.com](http://www.m-w.com), are also consistent with the view that the lattice in Kendall is not taut – e.g. defining “taut” as “having no give or slack: tightly drawn”. One of ordinary skill in the art would recognize that a hammock-like structure that cradles a foot is not a taut lattice. Therefore, Applicants amended the language of claims 1, 13, 34, and 35 to eliminate the possibility of interpreting the claim in the manner in which the Examiner originally had interpreted it. Accordingly, Kendall does not teach or suggest a grid system that forms a taut lattice pattern, nor does Kendall teach or suggest a grid system which forms a spring-like member capable of deflection and return, as recited in amended independent claims 1, 13, 34, and 35.

In contrast to Kendall, amended claims 1, 13, 34, and 35 are directed to spring-like systems in selected areas of the midsole insert for the purpose of storing energy during the compression portions of a gait cycle and releasing energy during the push-off phase of the gait cycle. Thus, claims 1, 13, 24, and 35 patentably distinguish over Kendall, such that the rejection under §102 should be withdrawn.

Claims 2, 6, and 7 depend from claim 1, and claims 14, 20, 21, 28, 29, 30, and 36 depend from claim 13 and all are thus patentable in view of Kendall for at least the same reasons.

***Rejections Under 35 U.S.C. §103***

In the Office Action, claims 3-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kendall.

Without acceding to the propriety of this rejection, claims 3-5 depend from independent claim 1 and are patentable for at least the same reasons set forth above. Accordingly, the rejection of these claims over Kendall should be withdrawn.

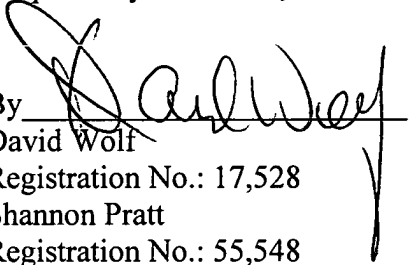
**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: January 30, 2006

Respectfully submitted,

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